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10/817,135	04/01/2004	Valerie J. Marty	200309766	1502
22879	7590	06/12/2006	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			CULBERT, ROBERTS P	
			ART UNIT	PAPER NUMBER
			1763	

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/817,135

**Applicant(s)**

MARTY ET AL.

**Examiner**

Roberts Culbert

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I (Claims 1-29) in the reply filed on 4/18/06 is acknowledged. The traversal is on the ground(s) that the inventions must be shown to be independent *and* distinct and a showing of undue burden must be made. This is not found persuasive because there is no requirement for distinct *and* independent inventions, as recited in the MPEP. Further, the inventions have been broadly recited to require extensive and unrelated searches placing an undue burden on the search and examination for both inventions.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 2 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "graphite-like" in claim 2 is a relative term, which renders the claim indefinite. The term "graphite like" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification (P8) broadly defines "graphite like" to include any molecular group having  $sp^2$  hybridization that resembles a fragment of a graphite sheet. However the definition itself is indefinite since no standard exists in the art for what may or may not resemble a fragment of a graphite sheet. Further the definition for "graphite-like" refers only to the subgroups of the self-assembling molecules and not to the substrate. No definition has been provided for a "graphite-like" substrate.

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Regarding claim 18, the phrase "may contain" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. Regarding Claim 1, the omitted step is the step of contacting the aligning surface with the substrate.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 3- 6, 8-10, 12-14, 16 and 23-28 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 6,180,239 to Whitesides et al.**

Regarding Claims 1, 6 and 23, Whitesides et al. teach a method creating a patterned feature on a substrate comprising: preparing a solution of organic molecules having self-assembling properties (27), applying the solution to an aligning surface (20), contacting the aligning surface with the substrate (30), and separating the aligning surface from the substrate, (Figure 1d) leaving patterns of the organic molecules on the substrate.

Regarding Claims 3 and 4, Whitesides et al. further teach preparing at least two different species of organic molecules to preferentially align to a plurality of features.

Regarding Claims 5 and 24, Whitesides et al. teach utilizing the ordered patterns of organic molecules as a mask.

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Regarding Claims 8 and 9, Whitesides et al. teach the organic molecules have a molecular head group, tail and optionally a functional group.

Regarding Claim 10, Whitesides et al. teach an aromatic ring functionality (benzyl group) *See for example, C11, L55 of U.S. Patent 5,512,131 incorporated by reference.*

Regarding Claim 12, Whitesides teach the ordered patterns include substantially parallel lines (Figure 4a) Note that the size of the tail group inherently helps determine the lateral spacing between lines although not expressly recited.

Regarding Claim 13, Whitesides et al. teach preparing a solvent system having organic molecules therein, and wherein the organic molecules used to prepare the solvent system determine the lateral spacing.

Regarding Claim 14, Whitesides et al. teach choosing a functional group based on process requirements.

Regarding Claim 16, Whitesides et al. teach the organic molecules contain a thiol group and the substrate a layer of gold. (*See Example 2, as well as U.S. Patent 5,512,131 incorporated by reference*)

Regarding Claim 20 Whitesides et al. teach the organic molecules are laterally spaced after they are applied as broadly claimed. Note that any plurality of molecules is "laterally spaced" as broadly claimed by applicant.

Regarding Claim 25, Whitesides et al. teach introducing additional organic molecule species to the surface, which preferentially align to the functional groups existing along defined patterns.

Regarding Claim 26, Whitesides et al. teach introducing additional organic molecule species having functional groups to the surface to cause certain molecules to preferentially align with according to functional groups along pre-defined patterns. (C13, L29-39)

Regarding Claims 27 and 28, Whitesides et al. teach etching the substrate.

***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 11, 15, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,180,239 to Whitesides et al. in view of U.S. Patent 6,562,398 to Braach-Maksvytis et al.**

Regarding Claims 11, 15 and 22, Whitesides teach phenyl groups on an alkyl hydrocarbon group and the like, (*See C11, L U.S. Patent 5,512,131 incorporated by reference*) but do not expressly teach biphenyl groups. However it is well known in the art of forming molecular structures having self-assembling properties to use biphenyl groups. For example, Braach-Maksvytis et al. (C7, L24-48) teach the use of biphenyl groups. It would have been obvious to one of ordinary skill in the art at the time of invention to use biphenyl groups in order to impart structural stabilizing characteristics to the molecules as taught by Braach-Maksvytis et al.

**Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,180,239 to Whitesides et al. in view of U.S. Patent 5,578,351 to Shashidhar et al.**

Regarding Claims 17-19, Whitesides teach platinum and palladium may be used as the substrate, (*See C10, L57-60 of U.S. Patent 5,512,131 incorporated by reference*) but do not expressly teach

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isocyanate groups. However it is well known in the art of forming molecular structures having self-assembling properties to use isocyanate groups with platinum or palladium. For example, Shashidhar et al. (C4, L45-65) teach the use of isocyanate groups with compatible surfaces such as platinum and palladium. It would have been obvious to one of ordinary skill in the art at the time of invention to use isocyanate groups in order to impart liquid crystalline characteristics to the molecules as taught by Shashidhar et al. Note that the limitation reciting particles of palladium preferentially align to the surface along aligned molecules according to their functional groups reads on a palladium substrate having an isocyanate functional group since the same will be preferentially aligned and the substrate contains particles of palladium.

**Claims 21 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,180,239 to Whitesides et al. in view of U.S. Patent 6,465,054 to Effenberger.**

Regarding Claims 21 and 29, Whitesides et al. teach the method of the invention substantially as claimed, but do not expressly teach solvating with an alkane solvent to control lateral spacing. However, the use of alkane solvent to increase spacing is well known in the art. For example, Effenberger teaches use of an alkane solvent to reduce the % coverage. (C6, L30-40). It would have been obvious to one of ordinary skill in the art at the time of invention to use an alkane solvent in order to increase spacing in the well-known manner.

#### ***Allowable Subject Matter***

Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.


#### ***Conclusion***

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberts Culbert whose telephone number is (571) 272-1433. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Parviz Hassanzadeh can be reached on (571) 272-1435. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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